

### **Remarks**

The Office Action mailed October 11, 2006 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicant believes that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 1-31 are now pending in this application, of which claims 1, 8, and 13 have been amended. Claims 22-31 are withdrawn from prosecution as being directed to a non-elected invention. It is respectfully submitted that the pending claims define allowable subject matter.

#### **A. The Restriction Requirement**

The Finality of the Restriction Requirement is not believed to be proper. In response to Applicants' arguments against the restriction requirement, the present Office Action again states in conclusory fashion that the storing of a product is "clearly" a materially different process than reusing the package or presenting the package at a point of purchase. No attempt has been made in the Office Action to explain any distinction between storing and re-use, no attempt has been made to actually apply the language of the claims to the restriction requirement, nor has any attempt to clarify the position taken by the Office on this issue been made. The cited example of storage of a product in a locker or refrigerator has no reasonable correlation to the invention as claimed.

Applicants accordingly consider the present Office Action to be generally non-responsive to the arguments made against the restriction, and Applicants submit that a prima facie basis for a restriction requirement has yet to be established on the record. Applicants remind the Office that a proper Office Action should respond to each and every argument of the Applicant so that prosecution may proceed with as few Office Actions as possible.

Applicants accordingly again request reconsideration of the restriction requirement and, if maintained, Applicants request that a proper basis therefor be established on the record for Applicants' consideration and reply.

B. The Prior Art Rejections

The prior art rejections will now be considered in the order set forth in the Office Action.

1. Franco et al.

The rejection of claims 1-21 under 35 U.S.C. § 102(b) as being anticipated by Franco et al. (U.S. Patent No. 4,506,769) is respectfully traversed.

Applicants note the following with respect to the applicable law of anticipation. As explained by the Federal Circuit, a Section 102(b) rejection on the ground of "anticipation" requires a disclosure in a single piece of prior art of each and every limitation of a claimed invention. A finding of anticipation requires that the publication describe all of the elements of the claims arranged as in the patented device. In other words, to anticipate, a single reference must teach every limitation of the claimed invention.

Franco et al. describe an activity bag system that includes an outer carrying bag (10), multiple interchangeable inner containers (12) shaped to fit in a close-fitting relationship within one section of the outer bag (10), and a combination container storage bag-storage cover (14). Franco et al. provides specific examples of uses for the interchangeable inner containers (12). Franco et al. describe a first inner container (12a) containing the necessary articles for soccer, including a ball, shoes, and shin guards. Franco et al. describe a second inner container (12b) containing necessary articles for equestrian activities. And Franco et al. describe a third inner container (12c) containing the necessary articles for tennis with shoes and tennis balls shown. Each inner container (12a, 12b, 12c) is described as being surrounded by a storage cover (14). Outer bag (10) is sized to hold each inner container (12a, 12b, 12c) within a lower container-receiving section (20). A lid section (18) is separable from the lower section (20) along three

sides of the bag and the two sections are hinged together along the fourth side at an integral fabric hinge (22). Closure means in the form of zippers (24) are provided along the parting edges of the three separable sides of the bag to fasten the lid and lower sections together in a closed position for carrying the contents of the bag.

Claim 1 recites a “dual-use product package comprising a non-food product; a non-rigid base defining a cavity holding said non-food product at a point of sale of said non-food product, said cavity configured to contain food products once the non-food product is removed from said cavity; a cover configured to close said cavity; and a closure member fastening said cover to said base.”

Notably, Franco et al. do not disclose that any of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are “product packages”. That is, none of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are described as holding any products for sale within the bag (10) or container (12a, 12b, 12c).

As stated above, in listed embodiments, Franco et al. describe inner containers (12a, 12b, 12c) holding necessary articles for soccer, including a ball, shoes, and shin guards, or containing necessary articles for equestrian activities. However, Franco et al. do not describe inner containers (12a, 12b, 12c) or outer bag (10) holding those articles for display or sale. Presumably, then, when the activity bag system is purchased, it does not include any articles within it. It is likely that when purchased, the activity bag system itself is contained within some-sort of product packaging. That product packaging may include a cardboard box surrounding the activity bag system that provides surfaces with which indicia describing the contents and features of the activity bag system may be placed. Furthermore, this cardboard box would likely be discarded by a purchaser of the activity bag system because the product package is not designed to have a significant secondary use other than to protect the activity bag system during transit and to add to the marketability of the activity bag system through printed indicia.

Furthermore, Franco et al. do not disclose that either outer bag (10) or the inner containers (12a, 12b, 12c) are configured to contain food products as the cavity of claim 1 is claimed to be configured. Franco et al. only mention food or beverage at col. 4, lines 46-49,

where an insulated pocket (41) for carrying a bottle or other container of hot or cold liquid is described. As shown in Figures 1 and 3, the insulated pocket (41) is external to the outer bag (10) and the inner containers (12a, 12b, 12c), whereas claim 1 recites, “said cavity configured to contain food products once the non-food product is removed from said cavity. . . .”

For at least the reasons set forth above, claim 1 is not anticipated by Franco et al. Also, because Franco et al. do not suggest the dual-use product package of claim 1, claim 1 is submitted to be patentable over Franco et al.

Claims 2-12 depend from claim 1, and when the dependent claims 2-12 are considered in combination with claim 1, claims 2-12 are likewise submitted to be patentable over Franco et al.

Claim 13 recites a “footwear package comprising: a support surface; a plurality of soft side walls extending from said support surface and defining a cavity for holding footwear above said support surface at a point of sale of said footwear, wherein at least one of said side walls comprises a flap folded over the remaining side walls to define a cover over said cavity; and a zipper selectively coupling and uncoupling said flap and said remaining side walls.”

Notably, Franco et al. do not disclose that any of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are a “footwear package”. That is, none of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are described as packaging footwear for sale in the bag/container. Franco et al. describe a first inner container (12a) containing the necessary articles for soccer, including a ball, shoes, and shin guards. However, Franco et al. do not describe the activity bag system including anything within it at the time the activity bag system is purchased. Applicants submit that the ordinary meaning of “footwear package,” as determined by a person of ordinary skill in art related to product packaging, would not include an activity bag system sold for the sole purpose of being an activity bag.

The words of a claim “are generally given their ordinary and customary meaning.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date

of the patent application. See Innova, 381 F.3d at 1116. The person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

It is well established that a patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swinheart, 169 USPQ 226, 228 (CCPA 1971). In construing a patent claim for examination, it is improper to ignore functional recitations. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); In re Venezia, 189 USPQ 149 (CCPA 1976). In a proper construction of the claims, all recitations of the claims must be considered. See MPEP § 2143.03 (all words in a claim must be considered in judging the patentability of the claim against the prior art).

The Federal Circuit has stated that there is no “litmus test” for determining whether preamble language of a claim is limiting. Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002). Whether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent. Storage Tech. Corp. v. Cisco Sys., Inc., 329 F.3d 823, 831 (Fed. Cir. 2003). Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345 (Fed. Cir. 2003); Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). However, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1305-06 (Fed. Cir. 2005), cert. denied, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); SanDisk Corp. v. Memorex Prods., Inc., 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 829 (2005). That is, if the claim drafter “chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Commc’ns Research, Inc. v. Vitalink Commc’ns Corp., 55 F.3d 615, 620 (Fed. Cir. 1995). Moreover, when the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a

necessary component of the claimed invention.” Eaton Corp. v. Rockwell Int’l Corp., 323 F.3d 1332, 1339 (Fed. Cir. 2003).

Applicants submit that the preamble of claim 1 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both the preamble and the body of claim 1. Applicants claim a “dual-use product package” to be sold containing a product and not an “activity bag” sold solely for its use as an activity bag.

Similarly, Applicants submit that the preamble of claim 13 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both the preamble and the body of claim 13. Applicants claim a “footwear package” to be sold containing footwear at the time of purchase and not an “activity bag” sold solely for its use as an activity bag.

For at least the reasons set forth above, claim 13 is not anticipated by Franco et al. Also, because Franco et al. do not suggest the footwear package of claim 13, claim 13 is submitted to be patentable over Franco et al.

Claims 14-21 depend from claim 13, and when the dependent claims 14-21 are considered in combination with claim 13, claims 14-21 are likewise submitted to be patentable over Franco et al.

Regarding the method claims 23-31, the recitations of these claims are likewise neither disclosed nor suggested by Franco et al., and the method claims are respectfully submitted to be patentable over Franco et al. for similar reasons to the product claims 1-21.

## 2. Davis

The rejection of claims 1-6 and 8-21 under 35 U.S.C. § 102(b) as being anticipated by Davis (U.S. Patent No. 4,434,601) is respectfully traversed. The rejection of claims 7 and 17 under 35 U.S.C. § 103(a) as obvious over Davis is also respectfully traversed.

Col 4, lines 9-16 of Davis are cited in the Office Action as teaching certain aspects of the claimed invention. Applicants respectfully disagree that Davis discloses the present invention.

Davis discloses a multiple compartment utility bag having three compartments serving different purposes. As noted by Davis at col. 4, lines 9-16, the utility bag includes a central compartment B for carrying soft drinks, an extensible end compartment A for holding soccer balls and athletic equipment, and a second end compartment C for holding smaller and foldable items such as clothing, towels, etc.

Claim 1 recites a “dual-use product package comprising a non-food product; a non-rigid base defining a cavity holding said non-food product at a point of sale of said non-food product, said cavity configured to contain food products once the non-food product is removed from said cavity; a cover configured to close said cavity; and a closure member fastening said cover to said base.”

Notably, Davis nowhere discloses the utility bag as a “product package”. That is, none of the compartments A, B and C of the Davis bag are described as packaging any of the associated products (soccer balls, athletic equipment, soft drinks, clothing and towels) for sale in the bag. Presumably, then, the utility bag, like many types of bags, is purchased separate and apart from the items to be carried in it. The Davis bag is therefore not properly characterized as a “product package” as the term is used in the specification and claims of the present application. Furthermore, Applicants submit that the ordinary meaning of “product package,” as determined by a person of ordinary skill in art related to product packaging, would not include a utility bag sold for the sole purpose of being a utility bag.

The words of a claim “are generally given their ordinary and customary meaning.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application. See Innova, 381 F.3d at 1116. The person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

It is well established that a patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swinheart, 169 USPQ 226, 228 (CCPA 1971). In construing a patent claim for examination, it is improper to ignore functional recitations. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); In re Venezia, 189 USPQ 149 (CCPA 1976). In a proper construction of the claims, all recitations of the claims must be considered. See MPEP § 2143.03 (all words in a claim must be considered in judging the patentability of the claim against the prior art).

The Federal Circuit has stated that there is no “litmus test” for determining whether preamble language of a claim is limiting. Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002). Whether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent. Storage Tech. Corp. v. Cisco Sys., Inc., 329 F.3d 823, 831 (Fed. Cir. 2003). Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345 (Fed. Cir. 2003); Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). However, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1305-06 (Fed. Cir. 2005), cert. denied, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); SanDisk Corp. v. Memorex Prods., Inc., 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 829 (2005). That is, if the claim drafter “chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp., 55 F.3d 615, 620 (Fed. Cir. 1995). Moreover, when the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed. Cir. 2003).

As argued above, Applicants submit that the preamble of claim 1 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both



the preamble and the body of claim 1. Applicants claim a “dual-use product package” to be sold containing a product, and do not claim an “activity bag” sold solely for its use as an activity bag.

Similarly, Applicants submit that the preamble of claim 13 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both the preamble and the body of claim 13. Applicants claim a “footwear package” to be sold containing footwear at the time of purchase and not an “activity bag” sold solely for its use as an activity bag.

Still further, Davis nowhere describes the compartment B being used in connection with non-food products as claim 1 clearly recites. Rather, only compartments A and C are described for containing non-food products. Similarly, neither of the compartments A or C is described in connection with food items, but rather only non-food items. None of compartments A, B or C are described in connection with both food and non-food products as claim 1 recites.

The Response to Arguments of the Office Action dated October 11, 2006 states that, “Examiner rejected claim 1 showing that Davis had a cavity that included compartments A,B and C, collectively. When taken together, the cavity (composed of compartments A,B and C) is used in connection with food and non-food items. Applicants respectfully submit that it is not reasonable to consider compartments A, B, and C to be a single cavity. It is Applicants understanding that compartments A, B, and C are separated from one another by a wall. Davis does not show these walls in the figures, however, Davis describes a zipper or slide fastener (26) for providing access to the second end compartment C (Col. 3, lines 5-8). Davis also describes slide fastener (30) that extends about a major portion of the circumference of the sleeve AS such that the end wall AW of the compartment may be dropped down in the manner of a flap to provide maximum access to the interior of the sleeve AS which serves as the extensible compartment A (Col 3, lines 28-34). Applicants submit that it is an unfair interpretation of Davis to conclude that compartments A, B, and C collectively constitute a cavity as claimed in claim 1. If compartments A, B, and C were not separated by interior walls, slide fasteners (26) and (30) would not be necessary to provide access to the end compartments C and A. Those compartments could be accessed through compartment B if they were not separated from compartment B by walls.

Applicants traverse the notion that Davis teaches a non-rigid base. Applicants note that compartment B of the Davis bag is an insulated compartment having polyurethane foam in the interior walls thereof, and the compartment B is disclosed in conjunction with beverage cans. While Davis is silent regarding whether the compartment walls are rigid or non-rigid, considering that the compartment B is intended for soft drink beverage cans it is likely that the compartment walls of Davis are relatively rigid to handle the weight and structural load of multiple beverage cans. From the standpoint of a user carrying the bag, a non-rigid compartment, particularly in the bottom or base portion of the compartment, would be undesirable for carrying full beverage cans. The bag would be difficult to carry unless the compartment B was relatively rigid, and the cans would be subject to a good deal of jostling and impact as the bag was handled if the compartment B was non-rigid.

Furthermore, the exemplary embodiments of non-rigid materials stated in Applicants' specification include nylon, canvas, and cloth. Applicants respectfully traverse the assertion that "as much as Applicant discloses/defines a "non-rigid" base, it is reasonable to at least think that the polyurethane foam is non-rigid in the sense that foams have forgiving, deformable surfaces." Applicants respectfully submit that in light of Applicants' specification, determining that a non-rigid base would include a base made of any foam because the foam may or may not include a forgiving, deformable surface is not a reasonable assertion. None of the exemplary embodiments, nylon, canvas, and cloth, would suggest that such a material is what Applicant meant as non-rigid.

The Office Action also states that, "Applicant argues Davis does not anticipate the invention 'adapted for use as a lunchbox'. This is unpersuasive because Davis discloses a compartment to hold food items certainly capable of being used as a lunchbox." Applicants respectfully traverse this assertion. The words of a claim "are generally given their ordinary and customary meaning." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application. See Innova, 381 F.3d at 1116. The person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular

claim in which the disputed term appears, but in the context of the entire patent, including the specification. Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Webster's New Millennium <sup>TM</sup> Dictionary of English defines a "lunchbox" as, "a container for regularly carrying one's midday meal." "lunchbox." *Webster's New Millennium<sup>TM</sup> Dictionary of English*, Preview Edition (v 0.9.6). Lexico Publishing Group, LLC. 10 Jan. 2007. According to the Office Action, Davis discloses a "lunchbox" simply because Davis discloses a compartment in a bag that may hold food items. Applicants respectfully submit that it is an unreasonable expansion of the term "lunchbox" to consider any container, including the container described by Davis, to be a lunchbox simply because food can be carried in the container. Applicants submit that the container of Davis would not be considered to be "a container for regularly carrying one's midday meal" by a person of ordinary skill in the art in question.

For at least the reasons set forth above, claim 1 is not anticipated by Davis. Also, because Davis does not suggest the dual-use product package of claim 1, claim 1 is submitted to be patentable over Davis.

Claims 2-12 depend from claim 1, and when the dependent claims 2-12 are considered in combination with claim 1, claims 2-12 are likewise submitted to be patentable over Davis

Claim 13 recites a "footwear package comprising: a support surface; a plurality of soft side walls extending from said support surface and defining a cavity for holding footwear above said support surface at a point of sale of said footwear, wherein at least one of said side walls comprises a flap folded over the remaining side walls to define a cover over said cavity; and a zipper selectively coupling and uncoupling said flap and said remaining side walls."

As noted above, Davis nowhere discloses anything being "packaged" in the utility bag within the meaning of the presently claimed invention. More specifically, as stated in the present Office Action, Davis does not disclose footwear being packaged in the bag. Also, as noted in paragraphs [0004] to [0006] of the present specification, footwear has conventionally been

packaged in relatively rigid cardboard boxes that are disadvantaged in a number of aspects. Davis neither recognizes nor resolves such problems, and does not render the present invention obvious.

Claim 13 is therefore submitted to be patentable over Davis.

Claims 14-21 depend from claim 13, and when the dependent claims 14-21 are considered in combination with claim 13, claims 14-21 are likewise submitted to be patentable over Davis.

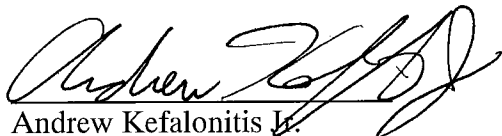
Applicants therefore respectfully request that the Section 102 rejection of claims 1-21 be withdrawn.

Regarding the method claims 23-31, the recitations of these claims are likewise neither disclosed nor suggested by Davis, and the method claims are respectfully submitted to be patentable over Davis for similar reasons to the product claims 1-21.

C. Conclusion

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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